



AR 12

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of:
Raymond J. Kelley et al.

Serial No.: 09/747,041

Filed: December 22, 2000

For: Web-Based Medical Diagnostic
System Financial Operation Planning
System and Method


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Group Art Unit: 3628

Examiner: Oyeibisi, Ojo O.

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APPEAL BRIEF PURSUANT TO 37 C.F.R. §§ 41.31 AND 41.37

This Appeal Brief is being filed in furtherance to the Notice of Appeal mailed on December 20, 2006, and received by the Patent Office on December 26, 2006, and the Notice of Panel Decision from Pre-Appeal Brief Review mailed February 27, 2007.

The Commissioner is authorized to charge the requisite fee of \$500.00 for this Appeal Brief, and any additional fees which may be necessary to advance prosecution of the present application, to Deposit Account No. 07-0845, Order No. 15-EC-5773/SWA (GEMS:0122).

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1. **REAL PARTY IN INTEREST**

The real party in interest is General Electric Company, which is the Assignee of the above-referenced application by virtue of the Assignment recorded at reel 011419, frame 0722, and recorded on December 22, 2000. General Electric Company, the Assignee of the above-referenced application as evidenced by the documents mentioned above, will be directly affected by the Board's decision in the pending appeal.

2. **RELATED APPEALS AND INTERFERENCES**

Appellants are unaware of any other appeals or interferences related to this appeal. The undersigned is Appellants' legal representative in this appeal.

3. **STATUS OF CLAIMS**

Claims 1-3, 5-25, 27-50, 52-54, and 56-58 are currently pending, are currently under final rejection, and, thus, are the subject of this appeal. Claims 4, 26, 51, 55, and 59 were previously cancelled and are not subject to this appeal.

4. **STATUS OF AMENDMENTS**

The instant claims have not been amended subsequent to the Final Office Action mailed September 20, 2006. Consequently, there are no outstanding amendments to be considered by the Board.

5. **SUMMARY OF CLAIMED SUBJECT MATTER**

The present invention relates generally to financial analysis systems and, more particularly, to a technique for providing a projected financial analysis of a medical facility. See Application, page 1, lines 7-9. The present application contains four independent claims, namely claims 1, 19, 34, and 43, all of which have been improperly rejected and, thus, subject to this appeal. The subject matter of the independent claims is summarized below.

With regard to the embodiment of the invention set forth in independent claim 1, discussions of the recited features of claim 1 can be found at least in the below cited locations of the specification and drawings. By way of example, an embodiment in accordance with the present invention relates to a method comprising providing an electronic form (*e.g.*, 94) comprising a medical-imaging-device purchase-analysis form (*e.g.*, 118) having fields configured to enable selection of a prospective medical imaging system from a plurality of medical imaging systems (*e.g.*, 134) and configured to enable entry of financial data (*e.g.*, 136, 138, 140) including system operational data (*e.g.*, 142) of the prospective medical imaging system, the financial data (*e.g.*, 136, 138, 140) comprising projected changes (*e.g.*, 143) in at least a portion of the financial data (*e.g.*, 136, 138, 140) over a future analysis period. *See, e.g.*, Application, FIGS. 2-4, page 11, lines 4-15; page 12, lines 23-31; page 14, line 1 – page 15, line 26. The method also includes electronically receiving the financial data (*e.g.*, 136, 138, 140) from the electronic form (*e.g.*, 94) via a network (*e.g.*, 80). *See, e.g.*, Application, FIG. 2, page 11, lines 4-15. The method further includes routing the financial data (*e.g.*, 136, 138, 140) into a financial analysis system (*e.g.*, 100). *See, e.g.*, Application, FIG. 2, page 11, line 4 – page 12, line 16. The method also includes generating a pro forma financial report (*e.g.*, 244) for the future analysis period tailored to the financial data (*e.g.*, 136, 138, 140). *See, e.g.*, Application, FIG. 2, page 12, lines 11-16; page 16, line 28 – page 18, line 30. The method further includes electronically transmitting the pro forma financial report (*e.g.*, 244) to a client (*e.g.*, 90) via the network (*e.g.*, 80). *See, e.g.*, Application, FIG. 2, page 12, lines 11-16. The method also includes analyzing a prospective purchasing option selected from a plurality of different purchasing options (*e.g.*, 172, 174) to obtain the prospective medical imaging system based on the financial data (*e.g.*, 136, 138, 140) of the client (*e.g.*, 90) to provide a client-specific financial analysis of the prospective purchasing option. *See, e.g.*, Application, FIG. 2, page 13, lines 24-30; page 15, lines 22-30; page 16, lines 7-9.

With respect to the embodiment of the invention set forth in independent claim 19, discussions of the recited features of claim 19 can be found at least in the below cited locations of the specification and drawings. By way of example, an embodiment in

accordance with the present invention relates to a system including a client computer system (*e.g.*, 90) for the medical facility, a financial analysis system (*e.g.*, 100) remote from the medical facility, and a network (*e.g.*, 80) for coupling the client computer system (*e.g.*, 90) to the financial analysis system (*e.g.*, 100). *See, e.g.*, Application, FIG. 2, page 11, line 4 – page 12, line 16. The system also includes an interface (*e.g.*, 94) accessible on the client computer system (*e.g.*, 90) via the network (*e.g.*, 80), wherein the interface (*e.g.*, 94) includes a medical-diagnostic-device purchase-analysis-form (*e.g.*, 118) having fields configured to enable selection of a prospective medical imaging system from a plurality of medical imaging systems (*e.g.*, 134) and for entering client data. *See, e.g.*, Application, FIGS. 2-4, page 11, lines 4-15; page 12, lines 23-31; page 14, line 1 – page 15, line 26. In addition, the interface (*e.g.*, 94) is configured to exchange the client data with the financial analysis system (*e.g.*, 100). *See, e.g.*, Application, FIG. 2, page 11, lines 4-15. The client data includes financial data (*e.g.*, 136, 138, 140) of the medical facility including system operational data (*e.g.*, 142) of the prospective medical imaging system. The financial analysis system (*e.g.*, 100) is configured to evaluate the client data and to generate a projected financial report (*e.g.*, 244) for the prospective medical imaging system tailored to the client data, wherein the projected financial report (*e.g.*, 244) enables a client (*e.g.*, 90) to evaluate feasibility of purchasing the prospective medical imaging system. *See, e.g.*, Application, FIG. 2, page 12, lines 11-16; page 13, lines 24-30; page 15, lines 22-30; page 16, lines 7-9; page 16, line 28 – page 18, line 30.

Regarding the embodiment of the invention set forth in independent claim 34, discussions of the recited features of claim 34 can be found at least in the below cited locations of the specification and drawings. By way of example, an embodiment in accordance with the present invention relates to a method including providing an interface having a form (*e.g.*, 94) with a medical-imaging-device purchase-analysis form (*e.g.*, 118) configured to enable selection of a prospective medical imaging system from a plurality of medical imaging systems (*e.g.*, 134) and for entering client data relating to the healthcare facility including system operational data (*e.g.*, 142) of the prospective medical imaging system. *See, e.g.*, Application, FIGS. 2-4, page 11, lines 4-15; page 12, lines 23-31; page

14, line 1 – page 15, line 26. The client data includes a healthcare category and financial data (*e.g.*, 136, 138, 140) having projected changes (*e.g.*, 143) in at least a portion of the financial data (*e.g.*, 136, 138, 140). *See, e.g.*, Application, FIG. 4, page 14, lines 18-25. The method also includes electronically accepting the financial data (*e.g.*, 136, 138, 140) from the interface at a financial analysis system (*e.g.*, 100) via a network (*e.g.*, 80). *See, e.g.*, Application, FIG. 2, page 11, line 4 – page 12, line 16. The method further includes financially analyzing and projecting at least a portion of the financial data (*e.g.*, 136, 138, 140) over a future outlook period via the financial analysis system (*e.g.*, 100). *See, e.g.*, Application, FIGS. 2-3, page 11, line 17 – page 12, line 16; page 16, lines 1-26. In addition, the method includes returning a pro forma financial report (*e.g.*, 244) to a client (*e.g.*, 90) via the network (*e.g.*, 80) to enable the client (*e.g.*, 90) to evaluate feasibility of a possible transaction (*e.g.*, 172, 174) to obtain the prospective medical imaging system for incorporation into operations of the client (*e.g.*, 90) at the healthcare facility. *See, e.g.*, Application, FIG. 2, page 12, lines 11-16; page 13, lines 24-30; page 15, lines 22-30; page 16, lines 7-9; page 16, line 28 – page 18, line 30.

Finally, with respect to the embodiment of the invention set forth in independent claim 43, discussions of the recited features of claim 43 can be found at least in the below cited locations of the specification and drawings. By way of example, an embodiment in accordance with the present invention relates to an Internet financial analysis system, which includes a client computer system (*e.g.*, 90) for the healthcare facility, a financial analysis system (*e.g.*, 100) remote from the healthcare facility, and a network (*e.g.*, 80) for exchanging data between the client computer system (*e.g.*, 90) and the financial analysis system (*e.g.*, 100). *See, e.g.*, Application, FIG. 2, page 11, line 4 – page 12, line 16. The system also includes an Internet query form (*e.g.*, 94) having a medical-diagnostic-device purchase-analysis-form (*e.g.*, 118) with a plurality of data entry fields configured for accepting financial data (*e.g.*, 136, 138, 140) of a prospective medical diagnostic system (*e.g.*, 134) for the healthcare facility, the Internet form (*e.g.*, 94) being accessible on the client computer system (*e.g.*, 90). *See, e.g.*, Application, FIGS. 2-4, page 11, lines 4-15; page 12, lines 23-31; page 14, line 1 – page 15, line 26. The plurality of data entry fields

include a medical operational time field (*e.g.*, 143) associated with efficiency of the prospective medical diagnostic system for a potential purchase transaction, a cost field (*e.g.*, 166) associated with the prospective medical diagnostic system, a revenue field (*e.g.*, 143, 146) associated with the prospective medical diagnostic system, and one or more purchase transaction option fields (*e.g.*, 172, 174) for the potential purchase. *See, e.g.*, Application, FIG. 4, page 14, lines 14-31. In addition, the system includes an Internet results page (*e.g.*, 244) for displaying a projected financial statistic from the financial analysis system (*e.g.*, 100), wherein the projected financial statistic indicates a financial outlook of the potential purchase transaction to assist an individual with the potential purchase transaction. *See, e.g.*, Application, FIG. 2, page 12, lines 11-16; page 13, lines 24-30; page 15, lines 22-30; page 16, lines 7-9; page 16, line 28 – page 18, line 30.

6. **GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

Sole Ground of Rejection for Review on Appeal:

Appellants respectfully urge the Board to review and reverse the Examiner's sole ground of rejection in which the Examiner improperly rejected claims 1-3, 5-25, 27-50, 52-54, and 56-58 under 35 U.S.C. § 103(a) as being unpatentable over Eder (US Patent 6,321,205, hereinafter "Eder").

7. **ARGUMENT**

Sole Ground of Rejection:

The Examiner improperly rejected claims 1-3, 5-25, 27-50, 52-54, and 56-58 under 35 U.S.C. § 103(a) as being unpatentable over Eder (US Patent 6,321,205, hereinafter "Eder"). Because this rejection is clearly and directly contrary to previous binding decisions of the Board, as well as the binding precedent of the Federal Circuit, Appellants respectfully traverse this rejection.

Legal Precedent

First, the pending claims must be given an interpretation that is reasonable and consistent with the *specification*. *See In re Prater*, 415 F.2d 1393, 1404-05, 162 U.S.P.Q.

541, 550-51 (C.C.P.A. 1969) (emphasis added); *see also In re Morris*, 127 F.3d 1048, 1054-55, 44 U.S.P.Q.2d 1023, 1027-28 (Fed. Cir. 1997); *see also* M.P.E.P. §§ 608.01(o) and 2111. Indeed, the specification is “the primary basis for construing the claims.” *See Phillips v. AWH Corp.*, No. 03-1269, -1286, at 13-16 (Fed. Cir. July 12, 2005) (*en banc*). One should rely *heavily* on the written description for guidance as to the meaning of the claims. *See id.*

Second, interpretation of the claims must also be consistent with the interpretation that *one of ordinary skill in the art* would reach. *See In re Cortright*, 165 F.3d 1353, 1359, 49 U.S.P.Q.2d 1464, 1468 (Fed. Cir. 1999); M.P.E.P. § 2111. “The inquiry into how a person of ordinary skill in the art understands a claim term provides an objective baseline from which to begin claim interpretation.” *See Collegenet, Inc. v. ApplyYourself, Inc.*, No. 04-1202, -1222, 1251, at 8-9 (Fed. Cir. August 2, 2005) (quoting *Phillips*, No. 03-1269, -1286, at 16). The Federal Circuit has made clear that derivation of a claim term must be based on “usage in the ordinary and accustomed meaning of the words amongst artisans of ordinary skill in the relevant art.” *See id.*

Third, the burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d. 1430 (Fed. Cir. 1990). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). The Examiner must provide objective evidence, rather

than subjective belief and unknown authority, of the requisite motivation or suggestion to combine or modify the cited references. *In re Lee*, 61 U.S.P.Q.2d. 1430 (Fed. Cir. 2002). Moreover, a statement that the proposed modification would have been “well within the ordinary skill of the art” based on individual knowledge of the claimed elements cannot be relied upon to establish a *prima facie* case of obviousness without some *objective reason to combine* the teachings of the references. *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993); *In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d. 1313, 1318 (Fed. Cir. 2000); *Al-Site Corp. v. VSI Int’l Inc.*, 174 F.3d 1308, 50 U.S.P.Q.2d. 1161 (Fed. Cir. 1999).

Fourth, when prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988). One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). The Federal Circuit has warned that the Examiner must not, “fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.” *In re Dembiczak*, F.3d 994, 999, 50 U.S.P.Q.2d 52 (Fed. Cir. 1999) (quoting *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983)).

Fifth, it is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 U.S.P.Q. 769, 779 (Fed. Cir. 1983); M.P.E.P. § 2145. Moreover, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (CCPA 1959); see M.P.E.P. § 2143.01(VI). If the proposed modification or combination would render the

prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); *see* M.P.E.P. § 2143.01(V).

Sixth, in order to rely on equivalence as a rationale supporting an obviousness rejection, the equivalency must be recognized in the prior art, and cannot be based on applicant's disclosure or the mere fact that the components at issue are functional or mechanical equivalents. *In re Ruff*, 256 F.2d 590, 118 U.S.P.Q. 340 (CCPA 1958); *see also* M.P.E.P. § 2144.06.

Preliminary Remarks

The Final Office included a "Response to Arguments" section beginning on page 17 and ending on page 21. In this section, the Examiner focused on the data rather than its function and interrelationship with the resulting report to enable a client to evaluate a prospective purchase option. For example, the Examiner stated:

Thus, the recitation of "operational data of medical imaging systems" and "medical-imaging-device purchasing analysis form", these information neither enhance nor diminish the functionality of the system. These information are nothing but a compilation of data, which coincides with the definition of non-functional descriptive material in MPEP 2106. In conclusion, when the prior art describes all the claimed structural and functional relationships between the descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the descriptive material is non-functional and will not be given any patentable weight. Final Office Action, page 18 (emphasis added).

First, the Appellants note that Section 2106 of the Manual of Patent Examining Procedure relates generally to 35 U.S.C. § 101 rather than § 103. The Appellants submit that the Examiner did not cite relevant law or guidelines pertaining to the rejections. Even in Section 2106, the Manual of Patent Examining Procedure states:

VI. DETERMINE WHETHER THE CLAIMED INVENTION COMPLIES
WITH 35 U.S.C. 102 AND 103

Reviewing a claimed invention for compliance with 35 U.S.C. 102 and 103 begins with a comparison of the claimed subject matter to what is known in the prior art. See MPEP § 2131 - § 2146 for specific guidance on patentability determinations under 35 U.S.C. § 102 and 103. If no differences are found between the claimed invention and the prior art, then the claimed invention lacks novelty and is to be rejected by USPTO personnel under 35 U.S.C. 102. Once differences are identified between the claimed invention and the prior art, those differences must be assessed and resolved in light of the knowledge possessed by a person of ordinary skill in the art. Against this backdrop, one must determine whether the invention would have been obvious at the time the invention was made. If not, the claimed invention satisfies 35 U.S.C. 103.

M.P.E.P. (Rev. 5, August 2006) § 2106, pages 2100-14 and 2100-15 (emphasis added).

The Appellants further emphasize that Section 2143.03 of the Manual of Patent Examining Procedure states:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

M.P.E.P. (Rev. 5, August 2006) § 2143.03, page 2100-131 (emphasis added). Clearly, the Examiner has disregarded certain features of the claims, rather than considering all words of the claims. In view of the passage above, the Examiner’s rejections are improper and cannot stand.

Second, the Appellants stress that the claims clearly correlate the data to a specific function, which is missing from the Eder reference. For example, the claims generally relate to a prospective purchase of medical equipment, and a report to enable a client to evaluate the feasibility of such a purchase. Specifically, independent claim 1 recites, *inter alia*, “analyzing a prospective purchasing option selected from a plurality of different purchasing options to obtain the prospective medical imaging system based on the financial data of the client to provide a client-specific financial analysis of the prospective purchasing option.” Specifically, independent claim 19 recites, *inter alia*,

“the financial analysis system is configured to evaluate the client data and to generate a projected financial report for the prospective medical imaging system tailored to the client data, wherein the projected financial report enables a client to evaluate feasibility of purchasing the prospective medical imaging system.” Specifically, independent claim 34 recites, *inter alia*, “returning a pro forma financial report to a client via the network to enable the client to evaluate feasibility of a possible transaction to obtain the prospective medical imaging system for incorporation into operations of the client at the healthcare facility.” Specifically, independent claim 43 recites, *inter alia*, “an Internet results page for displaying a projected financial statistic from the financial analysis system, wherein the projected financial statistic indicates a financial outlook of the potential purchase transaction to assist an individual with the potential purchase transaction.”

In sharp contrast, the Eder reference merely discloses general business evaluation, rather than anything related to a specific purchase transaction. Even outside the context of medical equipment, the Eder reference clearly fails to teach or suggest analysis of a prospective purchase transaction in which operational data of the equipment is analyzed in the process. Although the Appellants do not intend or suggest that the specification should be read into the claims, the Appellants submit that the specification provides context and meaning to the claims. For example, the specification discloses:

The medical resources employed at a particular medical institution greatly impact the efficiency, cost and revenue associated with a desired medical procedure. For example, a current system may allow a procedure to be completed in 20 minutes with 10 minutes of setup time, while another system may complete the procedure in 10 minutes with only 2 minutes of setup time. Less time means more procedures, and thus more revenue and lower patient waiting time for the procedures. As medical technology advances, particularly in the area of electronics and computer aided instruments, medical institutions must evaluate the feasibility of investing in new, additional or upgraded medical resources to better serve patients and become more efficient and profitable.

...

Unfortunately, the seller may provide limited options for purchasing the desired medical resource, and may not readily provide a prospective purchaser (e.g., the medical institution) with such information. The seller

may simply ignore the financial position of the prospective purchaser, and offer a standard transaction option not suitable or feasible for that purchaser.

...

Accordingly, there is a need for a technique for analyzing a desired medical resource investment for a medical institution based on financial data from the medical institution, and for providing a plurality of transaction options tailored to the financial data. More particularly, there is a need for a financial analysis system allowing interactive exchange of information, such as client data and transaction options, between a remote client interface and the financial analysis system via a network.

Application, page 1, lines 18-27; page 3, lines 8-12 and 25-30; page 4, line 1. In view of these passages, the Appellants stress that the present claims recite prospective purchasing options that are client-specific or tailored to the client based on the client's data, e.g., operational data associated with the relevant equipment. The Eder reference simply fails to teach or suggest such a system and method.

Third, the Examiner asserted that certain claim features are merely an intended use, and that the Eder reference teaches a system capable of performing such an intended use. *See* Final Office Action, page 17. However, the Appellants stress that the present claims recite much more than a mere intended use of the Eder system in the field of medicine. Again, the Eder reference does not teach or suggest a prospective purchase analysis for a specific piece of equipment, much less a piece of medical equipment. For example, not only is the Eder reference missing a “device purchase-analysis form,” but the Eder reference is missing a “medical-imaging-device purchase-analysis form” as recited in claim 1. The claim does not merely recite a generic form for use with medical data, but the form itself is specifically claimed as a “medical-imaging-device purchase-analysis form.” Although Eder may include some sort of forms that could hypothetically be used with medical data, the Eder reference clearly fails to disclose the specific type of form recited in the present claims, e.g., “medical-imaging-device purchase-analysis form.” Moreover, the Eder reference fails to disclose use of forms for purchase analysis of specific equipment. For at least these reasons, among others, the Appellants stress that the Examiner's rejection is improper and cannot stand.

Features of independent claim 1 missing from Eder

Claim 1 recites “providing an electronic form comprising a medical-imaging-device purchase-analysis form configured to enable selection of fields for selecting a prospective medical imaging system”. Further, the form is “configured to enable entry of financial data including system operational data for the prospective medical imaging system.”

In contrast, the Eder reference fails to teach or suggest an “electronic form comprising a medical-imaging-device purchase-analysis form configured to enable selection of fields for selecting a prospective medical imaging system.” Nor does Eder teach system operational data for the medical imaging system. Eder discloses *general non-medical* user inputs which define data fields used by software. *See* col. 18, lines 12-20. The software taught by the Eder reference is directed towards extracting, aggregating and storing transaction data associated with *intangible* assets. *See*, Eder, col. 8, lines 1-10; col. 5, lines 12-15. Hence, the forms taught by Eder are incapable of accommodating system operational data of a medical imaging system. For example, system operational data include a variety of operational data determined by the medical imaging system’s specification, such as operational and maintenance cost, patient throughput, availability, etc. These parameters are specific to a medical imaging system and cannot be covered by the forms provided by Eder. Further, in rejecting the claims, the Examiner pointed out instances in which Eder discloses system operational data. *See* Final Office Action, page 4. Appellants contend that no such disclosure appears to be found in the Eder reference. Absent any such disclosure, the rejection of claim 1 cannot stand.

Further, claim 1 recites “analyzing a prospective purchasing option...to obtain the prospective medical imaging system”, based on the financial data of the client “to provide a client-specific financial analysis of the prospective purchasing option.” In contrast, the Eder reference discloses generic purchasing subsystems, wherein “[t]hese systems incorporate worksheets, files, tables and databases...[that] contain information about the company operations and its related accounting transactions.” *See, e.g.*, Eder, col. 12,

lines 57-60; *see also* table 6. Thus, the systems disclosed by the Eder reference are not specifically tailored for analyzing a prospective purchase of a system, much less a medical imaging system.

In addition, the Examiner rejected the claims on grounds of intended use as applied to a medical facility. *See* Final Office Action, page 2. Appellants submit that the rejection cannot stand on such grounds because Eder simply does not disclose a medical-imaging-device purchase-analysis form configured to enable selection of fields for selecting a prospective medical imaging system, as recited by claim 1. Consequently, the features of claim 1 recited and discussed above are integral with and stem from the medical-imaging-device purchase-analysis form. In view of the foregoing remarks, the issue of intended use is moot.

For at least these reasons, independent claim 1 and its dependent claims are believed to be allowable over the cited reference.

Features of independent claim 19 missing from Eder

Claim 19 recites an interface, “wherein the interface includes a *medical-diagnostic-device purchase-analysis-form* having fields configured to enable selection of a prospective medical imaging system”. Claim 19 further recites a system configured to generate a projected financial report tailored to client data “wherein the projected financial report enables a client to evaluate feasibility of purchasing the prospective medical imaging systems.”

In stark contrast, Eder is absolutely devoid of an interface which includes a medical-diagnostic-device purchase-analysis-form having fields configured to enable selection of a prospective medical imaging system. Similarly, Eder is devoid of a financial report tailored to such systems. *See, generally*, Eder, col. 12, lines 32-67; Figures 1-9C. The cited reference clearly fails to disclose techniques for evaluating client data associated with a medical imaging system. The system disclosed by Eder is

incompatible with specific financial data (e.g., variable and fixed costs, revenues, deductions, etc.) of *medical* imaging systems. The types of *interfaces* and *financial reports* recited in claim 19 are clearly structured or configured for *evaluating client data of a medical imaging system*, and are not a simple representation of applying the generic business accounting techniques disclosed in Eder to a medical imaging system. Rather, the claimed *interface* and *financial report* denotes types of interfaces and financial reports that are different than any interface or report described in the Eder reference.

Further, in rejecting the claim the Examiner pointed out that the Eder reference discloses the claimed “wherein the projected financial report enables a client to evaluate feasibility of purchasing the desired system.” Final Office Action, page 6. However, the Examiner does not appear to indicate where such disclosure is found in the Eder reference. Absent any such disclosure, the rejection of claims 19 is improper and should be withdrawn.

In addition, the Examiner rejected the claim based on grounds of intended use. See Final Office Action, page 6. Appellants submit that Eder simply does not disclose an interface, wherein the interface includes a medical-diagnostic-device purchase-analysis-form. Therefore, the issue of intended use is irrelevant and should not constitute grounds for rejecting the claim. Accordingly, for at least these reasons, independent claim 19 and its dependent claims are believed to be allowable over the cited reference.

Features of independent claim 34 missing from Eder

Claim 34 recites “providing an interface having a form comprising a medical-imaging-device purchase-analysis form configured to enable selection of prospective medical imaging system” and a form for “entering *client data* relating to the healthcare facility including system operational data of the prospective medical imaging system.”

Conversely, the Eder reference does not teach or suggest a *form* for entering of client data related to a healthcare facility and/or a medical imaging system. Instead, as

discussed above, Eder provides for forms to extract, aggregate and store transaction data associated with *intangible* assets (not system operational data). Eder, col. 8, lines 1-10; col. 5, lines 12-15.

Independent claim 34 further recites “returning a pro forma financial report to a client via the network to enable the client to evaluate feasibility of a possible transaction to obtain the prospective medical imaging system.” The Eder system displays financial forecasts projecting a firm’s growth based on option pricing and cash flow analysis. Eder col. 6, lines 25-64. Eder simply does not disclose returning a pro forma financial report, much less a pro forma financial report to enable a client to evaluate feasibility of a transaction to obtain a medical imaging system. Therefore, for at least these reasons, independent claim 34 and its dependent claims are believed to be allowable over the Eder reference.

Features of independent claim 43 missing from Eder

Claim 43 recites “an Internet query form having a medical-diagnostic-device purchase-analysis-form having a plurality of data entry fields configured for accepting financial data of a prospective medical diagnostic system”, wherein the entry fields include “a medical *operational time field associated with efficiency of the prospective medical diagnostic system for a potential purchase transaction*.” Claim 43 further recites “a revenue field associated with the medical diagnostic system.”

In contrast, Eder does not teach or suggest an internet query *form* having data entry *fields* accepting financial data of a medical diagnostic system. Furthermore, Eder clearly does not disclose a *system* for financially analyzing a potential purchase transaction of a prospective medical diagnostic system. Thus, Eder can not teach the related *Internet results page*. Again, Eder instead provides a financial forecast based on option pricing and cash flow analysis. Eder col. 6, lines 25-64.

Further, in rejecting claim 43, the Examiner used an intended use type argument. *See* Office Action, pages 11, 12. However, because Eder is devoid of an Internet query form having a medical-diagnostic-device purchase-analysis-form having a plurality of data entry fields configured for accepting financial data, such an argument can not stand in rejecting the claim. Therefore, for at least this reason and for those stated above, independent claim 43 and its dependent claims are believed to be allowable over the Eder reference.

Features of dependent claim 53 missing from Eder

Claim 53 is directly dependent from claim 1. The claim recites “medical resource options include a magnetic resonance imaging (MRI) system, a computed tomography (CT) system, an ultrasound system, or any combination thereof.” Again, Appellants respectfully submit the modalities recited in the above claim are not disclosed or suggested by the Eder reference. More critically, the forms provided by Eder are not suitable for providing fields to accept financial data including system operational data of imaging systems, such as MRI, CT, ultrasound or any combination thereof. For at least these reasons, independent claim 53 is believed to be allowable over Eder.

Request Reversal of Rejection

For these reasons, among others, the Appellants respectfully request reversal of the rejections under 35 U.S.C. § 103.

Improper Combination - Lack of Objective Evidence of Reasons to Combine

In addition, the Examiner has not shown the requisite motivation or suggestion to modify the cited reference to reach the present claims. As summarized above, the Examiner must provide objective evidence, rather than subjective belief and unknown authority, of the requisite motivation or suggestion to combine or modify the cited reference. *In re Lee*, 61 U.S.P.Q.2d. 1430 (Fed. Cir. 2002). In the present rejection, the Examiner modified the cited reference based, for example, on the *conclusory and subjective statement*, stating that “it would have been obvious to one of ordinary skill in

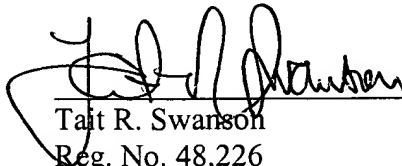
the art to apply the modeling and analyzing business improvement programs thought by Eder to medical imaging financial system operation to enable medical care professionals to use a broad array of assumptions to forecast utilization of medical procedures and estimated revenue per procedure under multiple capitation scenarios and to provide for a more comprehensive and efficient system for financial/management analysis of medical business operations.” Final Office Action, page 4. Accordingly, in view of the missing objective evidence, the Appellants respectfully request removal of the foregoing rejection under 35 U.S.C. § 103.

Conclusion

In view of the above remarks, Appellants respectfully submit that the Examiner has provided no supportable position or evidence that would justify the present improper rejections of the present claims. Consequently, Appellants respectfully submit that all pending claims are in condition for allowance. However, if the Examiner or Board wishes to resolve any other issues by way of a telephone conference, the Examiner or Board is kindly invited to contact the undersigned attorney at the telephone number indicated below.

Respectfully submitted,

Date: March 27, 2007



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8. **CLAIMS APPENDIX**

Listing of Claims:

1. A method comprising:
providing an electronic form comprising a medical-imaging-device purchase-analysis form having fields configured to enable selection of a prospective medical imaging system from a plurality of medical imaging systems and configured to enable entry of financial data including system operational data of the prospective medical imaging system, the financial data comprising projected changes in at least a portion of the financial data over a future analysis period;
electronically receiving the financial data from the electronic form via a network;
routing the financial data into a financial analysis system;
generating a pro forma financial report for the future analysis period tailored to the financial data;
electronically transmitting the pro forma financial report to a client via the network ;
and
analyzing a prospective purchasing option selected from a plurality of different purchasing options to obtain the prospective medical imaging system based on the financial data of the client to provide a client-specific financial analysis of the prospective purchasing option.
2. The method of claim 1, comprising identifying the client and tailoring the electronic form to the client.
3. The method of claim 1, wherein providing an electronic form having fields comprises allowing the client to select a prospective healthcare category.

5. The method of claim 1, wherein providing an electronic form having fields comprises allowing data entry of a fixed cost of operating the prospective medical imaging system.

6. The method of claim 1, wherein providing an electronic form having fields comprises allowing data entry of a variable cost of operating the prospective medical imaging system.

7. The method of claim 1, wherein providing an electronic form having fields comprises allowing data entry of a projected growth of a cost of operating the prospective medical imaging system.

8. The method of claim 1, wherein providing an electronic form having fields comprises allowing data entry of a wage statistic for operators of the prospective medical imaging system.

9. The method of claim 1, wherein providing an electronic form having fields comprises allowing data entry of an indirect labor statistic for employees of the prospective medical imaging system.

10. The method of claim 1, wherein providing an electronic form having fields comprises allowing data entry of a medical supply cost for the prospective medical imaging system.

11. The method of claim 1, wherein providing an electronic form having fields comprises allowing data entry of a medical equipment cost for the prospective medical imaging system.

12. The method of claim 1, wherein providing an electronic form having fields comprises allowing data entry of a tax statistic for the prospective medical imaging system.

13. The method of claim 1, wherein providing an electronic form having fields comprises allowing data entry of an overhead cost for the prospective medical imaging system.

14. The method of claim 1, wherein providing an electronic form having fields comprises allowing data entry of a medical procedure volume per time period for the prospective medical imaging system.

15. The method of claim 1, wherein providing an electronic form having fields comprises allowing data entry of a service charge per medical procedure provided by the prospective medical imaging system.

16. The method of claim 1, comprising allowing data entry of a financing amount, interest rate and financing period for the prospective medical imaging system.

17. The method of claim 1, comprising providing a set of financial rules for analyzing the financial data with the financial analysis system.

18. The method of claim 1, wherein electronically receiving comprises electronically receiving the financial data via the Internet.

19. A system comprising:

a client computer system for the medical facility;

a financial analysis system remote from the medical facility;

a network for coupling the client computer system to the financial analysis system;

and

an interface accessible on the client computer system via the network, wherein the interface includes a medical-diagnostic-device purchase-analysis-form having fields configured to enable selection of a prospective medical imaging system from a plurality of medical imaging systems and for entering

client data, wherein the interface is configured to exchange the client data with the financial analysis system, the client data comprising financial data of the medical facility including system operational data of the prospective medical imaging system, and wherein the financial analysis system is configured to evaluate the client data and to generate a projected financial report for the prospective medical imaging system tailored to the client data, wherein the projected financial report enables a client to evaluate feasibility of purchasing the prospective medical imaging system.

20. The system of claim 19, wherein the financial analysis system comprises a financial rule module.

21. The system of claim 19, wherein the financial analysis system comprises a tax module having rules for evaluating tax effects on the financial data.

22. The system of claim 19, wherein the financial analysis system comprises a healthcare module having rules for financially evaluating healthcare operational data relating to the prospective medical imaging system.

23. The system of claim 19, wherein the network comprises the Internet.

24. The system of claim 19, wherein the interface comprises a form configured for entering and transmitting the client data to the financial analysis system.

25. The system of claim 19, wherein the interface comprises a data entry field for a prospective healthcare category.

27. The system of claim 19, wherein the interface comprises a data entry field for a medical supply cost for the prospective medical imaging system.

28. The system of claim 19, wherein the interface comprises a data entry field for a medical equipment cost for the prospective medical imaging system.

29. The system of claim 19, wherein the interface comprises a data entry field for a medical procedure volume per time period for the prospective medical imaging system.

30. The system of claim 19, wherein the interface comprises a data entry field for a service charge per medical procedure provided by the prospective medical imaging system.

31. The system of claim 19, wherein the interface comprises a data entry field for a revenue statistic and a projected growth relating to the prospective medical imaging system.

32. The system of claim 19, wherein the interface comprises a data entry field for an equipment cost for the prospective medical imaging system.

33. The system of claim 19, wherein the interface comprises a data entry field for a financing amount, interest rate and financing period for the prospective medical imaging system.

34. A method comprising:
providing an interface having a form comprising a medical-imaging-device purchase-analysis form configured to enable selection of a prospective medical imaging system from a plurality of medical imaging systems and for entering client data relating to the healthcare facility including system operational data of the prospective medical imaging system, wherein the client data comprises a healthcare category and financial data including projected changes in at least a portion of the financial data;

electronically accepting the financial data from the interface at a financial analysis system via a network;

financially analyzing and projecting at least a portion of the financial data over a future outlook period via the financial analysis system; and

returning a pro forma financial report to a client via the network to enable the client to evaluate feasibility of a possible transaction to obtain the prospective medical imaging system for incorporation into operations of the client at the healthcare facility.

35. The method of claim 34, comprising identifying the client and tailoring the form to the client.

36. The method of claim 34, comprising tailoring the form to the healthcare category, wherein the healthcare category is associated with at least one of the plurality of medical imaging systems.

37. The method of claim 34, wherein providing the interface comprises providing a server for exchanging information between the financial analysis system and a client computer system for the healthcare facility.

38. The method of claim 34, wherein providing the interface comprises providing a field for entering a medical supply cost for the healthcare facility.

39. The method of claim 34, wherein providing the interface comprises providing a field for entering a medical equipment cost for the healthcare facility.

40. The method of claim 34, wherein providing the interface comprises providing a field for entering a medical procedure revenue statistic for the prospective medical imaging system.

41. The method of claim 40, comprising providing a field for entering a projected growth for the medical procedure revenue statistic.

42. The method of claim 34, wherein electronically accepting comprises electronically accepting the financial data via the Internet.

43. An Internet financial analysis system, the system comprising:
a client computer system for the healthcare facility;
a financial analysis system remote from the healthcare facility;
a network for exchanging data between the client computer system and the financial analysis system;
an Internet query form having a medical-diagnostic-device purchase-analysis-form having a plurality of data entry fields configured for accepting financial data of a prospective medical diagnostic system for the healthcare facility, the Internet form being accessible on the client computer system, wherein the plurality of data entry fields include a medical operational time field associated with efficiency of the prospective medical diagnostic system for a potential purchase transaction, a cost field associated with the prospective medical diagnostic system, a revenue field associated with the prospective medical diagnostic system, and one or more purchase transaction option fields for the potential purchase; and
an Internet results page for displaying a projected financial statistic from the financial analysis system, wherein the projected financial statistic indicates a financial outlook of the potential purchase transaction to assist an individual with the potential purchase transaction.

44. The system of claim 43, wherein the financial analysis system comprises a healthcare module having rules for financially evaluating operations of the prospective medical diagnostic system.

45. The system of claim 43, comprising an interface for viewing the Internet query form and the Internet results page, and for communicating between the client computer system and the financial analysis system.

46. The system of claim 45, comprising an identification system configured for identifying a client and tailoring the interface to the client.

47. The system of claim 43, wherein the plurality of data entry fields comprise a field for selecting the prospective medical diagnostic system from a list of medical diagnostic systems.

48. The system of claim 43, wherein the plurality of data entry fields comprise a field for a projected growth of a cost of operating the prospective medical diagnostic system.

49. The system of claim 43, wherein the plurality of data entry fields comprise a field for a projected growth of a healthcare procedure with the prospective medical diagnostic system.

50. The system of claim 43, wherein the plurality of data entry fields comprise fields for a financing amount, interest rate and financing period for the prospective medical diagnostic system.

52. The method of claim 1, comprising automatically creating a Web page, including the pro forma financial report, tailored to the client-specific financial analysis to enable the client to evaluate feasibility of the prospective purchasing option for the prospective medical imaging system.

53. The method of claim 1, wherein the prospective medical imaging system is selected from medical resource options on the electronic form, wherein the medical

resource options include a magnetic resonance imaging (MRI) system, a computed tomography (CT) system, an ultrasound system, or any combination thereof.

54. The method of claim 34, wherein providing the interface having the form comprises providing purchasing option fields and medical-specific fields, including medical diagnostic system options, client-specific operational data, and the financial data.

56 The method of claim 1, wherein the fields include a medical operational time field, a medical services per time field, a monetary cost per medical service field, and a revenue per medical service field, wherein the pro forma financial report provides one or more indications of feasibility of purchasing the prospective medical imaging system.

57. The system of claim 19, wherein the interface includes a medical operational time field associated with efficiency of the prospective medical imaging system for a potential purchase transaction, a cost field associated with the prospective medical imaging system, a revenue field associated with the prospective medical imaging system, and one or more purchase transaction option fields for the potential purchase transaction, wherein the projected financial report is configured to indicate a financial outlook of the potential purchase transaction to assist an individual with the potential purchase transaction.

58. The method of claim 34, wherein the form comprises a medical operational time field, a medical services per time field, a monetary cost per medical service field, and a revenue per medical service field, wherein the pro forma financial report provides one or more indications of feasibility of purchasing the prospective medical imaging system.

9. **EVIDENCE APPENDIX**

none

10. **RELATED PROCEEDINGS APPENDIX**

none